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OFFICE OF PETITIONS

In re Application of :
Dennison, et al. :
Application No. 10/020,741 : DECISION ON PETITION
Filed: 12 December, 2001 :
Attorney Docket No.: 2269-3259.1US (91- :
0473.02/RE) :

This is a decision on the petition filed on 25 May, 2005, under 37 C.F.R. §1.183, to waive provisions of 37 C.F.R. §1.67 and §1.172.

For the reasons set forth below, the petition under 37 C.F.R. §1.183 to waive provisions of 37 C.F.R. §1.67 and §1.172 is **GRANTED**.

BACKGROUND

The record reflects that:

- the instant application, filed on 12 December, 2001, is a reissue application of Patent No. 5,270,241, which issued on 14 December, 1993;
- in an *Ex parte Quayle* action mailed on 10 January, 2005, with reply due absent extension of time on or before 10 March, 2005, the Examiner required a supplemental re-issue oath/declaration;
- Petitioner herein alleges that, while co-inventor Michael A. Walker executed the requisite

oath/declaration, efforts to obtain the signature of co-inventor Charles H. Dennison (Mr. Dennison) have been unsuccessful, as reported and supported by the Declaration of Petitioner Joseph Walkowski (Reg. No. 28,765) that copies of the original patent, the instant application and the allowed claims were transmitted to Mr. Dennison along with the supplemental reissue oath/declaration

- however, despite Petitioner's diligence and follow-up inquiry(ies), as of the filing of the instant petition Petitioner received no response from Mr. Dennison and/or Mr. Dennison otherwise has failed to sign the declaration.

ANALYSIS

Having failed to obtain for filing the required fully executed declaration under 37 C.F.R. 37 C.F.R. §1.67¹ §1.172,² Petitioner:

¹ The regulations at 37 C.F.R. §1.67 provide:

§ 1.67 Supplemental oath or declaration.

(a) The Office may require, or inventors and applicants may submit, a supplemental oath or declaration meeting the requirements of §1.63 or § 1.162 to correct any deficiencies or inaccuracies present in the earlier filed oath or declaration.

(1) Deficiencies or inaccuracies relating to all the inventors or applicants (§§ 1.42, 1.43, or § 1.47) may be corrected with a supplemental oath or declaration signed by all the inventors or applicants.

(2) Deficiencies or inaccuracies relating to fewer than all of the inventor(s) or applicant(s) (§§ 1.42, 1.43 or § 1.47) may be corrected with a supplemental oath or declaration identifying the entire inventive entity but signed only by the inventor(s) or applicant(s) to whom the error or deficiency relates.

(3) Deficiencies or inaccuracies due to the failure to meet the requirements of § 1.63(c) (e.g., to correct the omission of a mailing address of an inventor) in an oath or declaration may be corrected with an application data sheet in accordance with § 1.76.

(4) Submission of a supplemental oath or declaration or an application data sheet (§ 1.76), as opposed to who must sign the supplemental oath or declaration or an application data sheet, is governed by § 1.33(a)(2) and paragraph (b) of this section.

(b) A supplemental oath or declaration meeting the requirements of § 1.63 must be filed when a claim is presented for matter originally shown or described but not substantially embraced in the statement of invention or claims originally presented or when an oath or declaration submitted in accordance with § 1.53(f) after the filing of the specification and any required drawings specifically and improperly refers to an amendment which includes new matter. No new matter may be introduced into a nonprovisional application after its filing date even if a supplemental oath or declaration is filed. In proper situations, the oath or declaration here required may be made on information and belief by an applicant other than the inventor.

(c) [Reserved]

[48 FR 2711, Jan. 20, 1983, effective Feb. 27, 1983; para. (c) added, 57 FR 2021, Jan. 17, 1992, effective Mar. 16, 1992; para. (b) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; para. (b) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised and para. (c) removed and reserved, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000]

² The regulations at 37 C.F.R. §1.172 provide:

§ 1.172 Applicants, assignees.

(a) A reissue oath must be signed and sworn to or declaration made by the inventor or inventors except as otherwise provided (see §§ 1.42, 1.43, 1.47), and must be accompanied by the written consent of all assignees, if any, owning an undivided interest in the patent, but a reissue oath may be made and sworn to or declaration made by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent. All assignees consenting to the reissue must establish their ownership interest in the patent by filing in the reissue application a submission in accordance with the provisions of § 3.73(b) of this chapter.

(b) A reissue will be granted to the original patentee, his legal representatives or assigns as the interest may appear.

[24 FR 10332, Dec. 22, 1959; para. (a), 48 FR 2713, Jan. 20, 1983, effective Feb. 27, 1983; para. (a) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

- attempted to approximate the showing of diligence as required under 37 C.F.R. §1.47 (though the provisions of 37 C.F.R. §1.47, *per se*, are not applicable in this manner), and
- sought remedy by a waiver under 37 C.F.R. §1.183³ of the requirements for all (both) inventors to sign the declaration under 37 C.F.R. §1.67 and §1.172 .

Petitioner represents that he has made a diligent effort to contact Mr. Dennison and have him join in the declaration under 37 C.F.R. §1.67 and §1.172, but that Mr. Dennison has failed to do so and that this failure creates an "extraordinary situation" as foreseen under 37 C.F.R. §1.183 requiring the invocation of the interests of justice.

To the extent that such waiver under 37 C.F.R. §1.183 is required so that the Examiner may now consider the declaration under 37 C.F.R. §1.67 and §1.172 as submitted, the petition is **granted** to permit such consideration; and further, the instant waiver is valid for the instant declaration and for any successive declaration that may have to be filed in the instant reissue application.

This file is released to Technology Center 2800 for further processing in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.



John J. Gillon, Jr.
Senior Attorney
Office of Petitions

³ The regulations at 37 C.F.R. §1.183 provide, in pertinent part:

§1.183 Suspension of the Rules.

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. * * *